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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,324	06/18/2001	Gregory F. Payne	8399-007-999	5267
7590	10/17/2003		EXAMINER	
Pennie & Edmonds 1667 K Street NW Washington, DC 20006			DELACROIX MUIRHEI, CYBILLE	
			ART UNIT	PAPER NUMBER
			1614	
			DATE MAILED: 10/17/2003	

16

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/763,324

**Applicant(s)**

PAYNE ET AL.

**Examiner**

Cybille Delacroix-Muirheid

**Art Unit**

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-28 is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

The following is responsive to Applicant's amendment received March 20, 2003.

Claims 29-34 are cancelled without prejudice or disclaimer. Claims 1-28 are currently pending.

The finality of the office action mailed Dec. 13, 2002 is withdrawn in view of the following new ground of rejection.

Applicant's Information Disclosure Statement received March 6, 2003 has been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

***New Ground(s) of Rejection***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-9, 12, 13, 15-19, 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wada et al., (submitted in the IDS of March 6, 2003).

Wada et al. disclose the invention substantially as claimed. Specifically, Wada et al. teach a method of solubilizing chitosan in acetic acid and water and adding it to a solution containing phosphate buffer, tyrosinase and a phenolic compound such as phenol, p-chlorophenol, p-cresol, resorcinol, etc. Figure 2 demonstrates the color removal from reactions solutions of phenol, p-chlorophenol incubated with tyrosinase and chitosan. Please see page 304, second column, first paragraph under Chemicals; page 305, first column Incubation Conditions and Analysis to second column up to Results and Discussion.

Art Unit: 1614

The claims are anticipated by Wada et al. because Wada et al disclose reacting identical compounds in a homogenous phase solution (i.e. the chitosan is in solution with the tyrosinase and phenolic compound) using Applicant's claimed method steps. Therefore, modification of the chitosan polymer or oligomer would be inherent. Moreover, the claimed properties of the modified chitosan, i.e. solubility and viscosity, would also be inherent.

***Claim Rejections—35 USC 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 1614

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 10-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wada et al., supra.

Wada et al. as applied above. In addition, Wada et al. disclose that the pH of the reaction solution is 7. Please see page 305, first column Incubation Conditions and Analysis to second column up to Results and Discussion.

However, Wada et al. do not disclose using reaction solutions having a pH of less than about 6.5 or a pH of at least about 8. Yet, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the pH of the reaction solution because Wada et al. recognizes the significance of pH as a variable when reacting the chitosan, enzyme and phenolic compound, and one of ordinary skill in the art would reasonably expect modification of pH as necessary for optimizing reaction conditions.

#### ***Allowable Subject Matter***

Claims 24-28 are free from the prior art because the prior art does not disclose or fairly suggest Applicant's claimed method.

#### ***Conclusion***

Claims 1-23 are rejected.

Art Unit: 1614

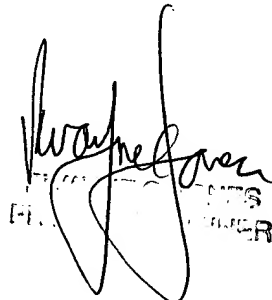
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is 703-306-3227. The examiner can normally be reached on Tue-Thur. from 8:30 to 6:00. The examiner can also be reached on alternate Mondays .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725 The fax phone number for the organization where this application or proceeding is assigned is 703-308-7924.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

CDM

Oct. 8, 2003



Handwritten signature of Cybille Delacroix-Muirheid, with a circular stamp partially visible behind it.